REMARKS

Reconsideration of this application and allowance of the claims is respectfully requested.

The objection to claim 64 has been corrected by amendment.

The amendments to claims 1, 32, and 49 are supported by Fig. 7 and page 12, lines 16-22.

No extra claim filing fee is due in view of the cancellation of claims 56 and 57.

With respect to the rejection of claim 6-8 and 17-18, it is submitted that the name "Elvis Presley" is entirely definite even though it comprises a trademark. This is so, because "Elvis Presley" is not just a trademark; it is a specific name of a specific individual concerning whom there is no possibility of misidentification! Of all people on earth, Elvis is one of the few who surely will not be misidentified.

The examiner has cited ex parte *Simpson* 218 USPQ 1020 (Bd. App. 1982). In that case, the trademark in question that appeared in a claim was to Hypalon, a halogenated material. The Board of Appeals held that term was indefinite in that case, because Hypalon, as sold, is a formulation of multiple ingredients, and thus that formulation could be of variable composition. The term did not literally describe, as the applicants attempted to make it describe, a particular type of halogenated molecule. Thus, it was indefinite.

However, with Elvis Presley, there is no indefiniteness. The claims are not using the term as a trademark, but rather they refer to the likeness of a particular, famous individual. The question of trademark infringement might arise if an unlicensed use is made of the likeness and persona of Elvis Presley although it is understood by

applicant's attorney that IGT, the owner of this application, is licensed from the estate of Elvis Presley.

Accordingly, it is submitted that claims 6-8 and 17-18 are entirely definite, in view of the unique character of the person Elvis Presley, this being quite contrary to the situation in ex parte *Simpson*.

The examiner has also rejected claim 1 and numerous other claims as anticipated by Walker et al. U.S. Patent No. 6,234,896.

Turning first to claim 1, the amended claim calls for a third outcome type which is a no win (i.e. losing) outcome (in which neither a monetary prize or an audiovisual display of the first and second winning outcomes is provided).

This is quite contrary to the disclosure of Walker et al., which clearly and strongly teaches that all outcomes are to be prize outcomes, receiving either a cash prize or a video presentation. In support of this, see, in Walker et al. 6,234,896, the abstract and particularly the last two lines; column 1, lines 62-65; column 4 and 5: the bridging paragraph; column 6, lines 34-43; and column 7, lines 20-23.

To the contrary, as stated, the third outcome type of claim 1 is a no win outcome. Typically by this invention, most of the outcomes of the game output are of the third type. See claims 72 and 73.

Thus, it is submitted that those skilled in the art, having Walker before them, would be strongly lead away from the invention of claim 1.

As further distinction, note claim 15, in which it is specified with respect to claim 1 that the video clip (of the second outcome) is selected randomly from a group of video clips. To the contrary, referring to Walker et al., note that the selection of video as

taught there is a directed selection, which clearly fails to be non-random. See column 3, lines 27-30, as well as column 4, lines 13-21. Accordingly, it is submitted that claim 15 adds significant patentable weight to claim 1, from which it depends.

The other dependent claims 2-27 are also believed to share in the patentable distinction of claim 1, since they ultimately depend from it.

Turning to claim 32, which is the next independent claim, we see a patent distinction similar to that which was discussed above with respect to claim 1. Note the language of the claim "...and a third, no win outcome type ... ".

As previously discussed with respect to claim 1, Walker et al. clearly teaches a situation where all outcomes receive either cash or a video prize. The teaching is repeated and strong in the specification, leading away those skilled in the art from the invention of claim 32.

Furthermore, the attention of the examiner is directed to claim 66, in which there is added to claim 32 the selection of the specific video clip and accompanying audio by a generally random process, which also is contrary to Walker et al., as discussed above with respect to the discussion of claim 15.

The other claims which are dependent upon claim 32 are also believed to be patentable, in that they share in the patentable distinction of claim 32.

Turning to claim 49, here also, there is required a third no win outcome type. As discussed above, this also represents a significant difference from what is strongly taught in Walker et al. It is submitted that those skilled in the art would simply be lead away from the invention of claim 49 by the disclosure as found in Walker et al.

Note also claim 69, which is dependent upon claim 49, and calls for the selection of motion pictures and accompanying audios to be by a generally random process.

Here also, it is submitted that Walker et al. so strongly leads away from what claim 49 and its dependent claims cover that it would not anticipate or render the invention defined in those claims obvious.

Furthermore, it is submitted that it would not be obvious to those skilled in the art, who are aware that in gaming there are almost always a substantial number of no win or losing outcomes, to combine that knowledge with Walker et al., in view of the strong leading away that is provided by the disclosure of Walker et al.

The examiner has rejected various dependent claims under 35 U.S.C. 103, stating that the various modifications would be obvious. However, it is submitted that the independent claims cited above each display that significant distinction from the disclosure of Walker discussed above, as well as their own distinctions.

The examiner has also rejected several claims including claim 54 as unpatentable over Walker in view of Acres et al. U.S. Patent No. 5,752,882.

Claim 54 calls for at least the option of a progressive prize display in the second section. However, as distinction over this combination of prior art, once again, an award of graphics, images, motion pictures, or other video clips may be selected by the player, contrary to the computer-directed, non-random selection of Walker et al. It is submitted that Acres et al. does not change the situation, since Acres does not relate to the playing of a video clip as a gaming prize.

Thus, claim 54 and its dependent claims are believed to be patentable.

Limitations from cancelled claim 56 have been included by amendment into claim 54.

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Registered Attorney for Applicant
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